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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,560

10/13/2006

John Waterfield

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

05/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,560	<b>Applicant(s)</b> WATERFIELD, JOHN	
	<b>Examiner</b> Frederick J. Parker	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,8 and 81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-2-08 has been entered.
2. The rejections of the previous Office Action are withdrawn in view of amendments and replaced with the new rejections and comments as follows:

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-4,8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer WO 97/09179 in view of the APA and Colton et al US2002/0132871.

Schafer teaches an improved measuring device/ ruler in which a transparent material, especially acrylic, is screen printed with thick lines to form multi-colored gradations which form the measuring units in at least one stage (pages 1,2,7,8 and elsewhere). The printing of "UV cured inks per claim 4 is taught (page 3, top). While non-slip characteristics is not cited, the APA states on page 1 that it is known and conventional in the art that solvent-based coatings having non-slip characteristics which are imparted by additions of a filler such as fine sand or pumice

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are printed onto the rulers after scalar markings have been applied. The coatings include, but are not limited to, an ink, adhesive, and varnish which may contain fine granular sand, pumice, etc per claims 3,12,15,17,18. Given such knowledge known in the art, one of ordinary skill would have looked for specific slip resistant coatings to apply to the device/ ruler of Schafer, and therefore have looked to Colton et al for a specific UV curable composition known to provide a permanent clear (thus not impeding viewing of the item measured nor the scalar markings beneath; claims 1,8,9,13) coat which protects underlying surfaces from scratching, abrading (= snag resistant), etc [0016] and may further incorporate particulate (=granular) of quartz (encompassing sand), alumina, etc [0074]. The coatings are rapidly UV curable, “normally in seconds” and with minimal heat [0019]. Photo-initiators are cited [abstract and elsewhere], per claim . While specific temperatures are not cited, the times of Colton are in the range of “within 30 seconds’ so one would have expected similar minimal temperatures. Furthermore, it is the Examiner’s position that curing time/ temperatures which are well-known cause-effective variables, would have been dictated by a variety of ordinary process parameters including, but not limited to, size of the coated substrate and coating thickness to be cured, curing initiator, coating composition, presence of additives (e.g. particulate fillers, etc) which modify UV curing, wave energy of the curing lamps as well as their size and number, etc . Applicants' specification and claims are entirely absent as to these critical aspects, and their lack of context simply fails to provide patentable significance to the specific UV process conditions as claimed. Therefore, given the process criteria disclosed by the prior art, it must be the Examiner’s position that Applicants time and temperature limitations are merely optimization by routine experimentation, which would not patentably distinguish over the prior art since they do not represent a patentable

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demarcation over the prior art. When a reference discloses the limitations of a claim except for a property, and the Examiner cannot determine if the reference inherently possesses that property (in this case, slip resistance ), the burden is shifted to Applicant/s, In re Fitzgerald 205 USPQ 594 and MPEP 2112. Further Colton et al teaches in [0067] that their composition does not contain any regulated or environmentally harmful solvent, providing yet further motivation to use the compositions of Colton in the overall process cited above.

Coloration of applied markings may be multi-color (page 10, top, of Schafer), the coloration of the lines being merely an obvious variation to supply image contrast and/ or decorative effects. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, In re Seid 73 USPQ 431. Per claims 10-11.

Per article claims 8-12, the product of the prior art would have been a measuring device/ ruler with cured UV inks including transparent lacquers (clm 9) formed by screen printing, the ink comprising sand, pumice, etc (clm 12) to form single or multi-color lines (clm 10-11).

Per claim 13, it is apparent the forming of any multi-coated ruler requires at least one discrete stage of forming, thereby meeting that limitation of claim 13.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the ruler/ device of Schafer using screen printing to form colored gradations and further imparting non-slip characteristics known according to the APA by further substituting or incorporating the specific UV curable coating materials containing fillers of Colton et al to provide the ruler with a wear and slip resistant surface formed by UV curing.

***Response to Arguments***

Applicants arguments were directed towards the previous prior art rejections withdrawn in view of Applicants' amendments. Thus, a response by the Examiner would be moot. Rebuttal to Applicants' new amendments are included in the rejections above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frederick J. Parker  
Primary Examiner  
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